

## **REMARKS**

Entry of the foregoing amendments, and favorable reconsideration of the above-identified application in view of the foregoing amendments and following Remarks, is respectfully requested pursuant to MPEP 706.07 or, alternatively, pursuant to 37 CFR 1.116 (a) and/or (b).

### **Withdrawal of the Finality of the Rejection**

It is respectfully requested that the finality of the rejection of the second Office Action of March 24, 2006 be withdrawn pursuant to MPEP 706.07 (a), 706.07 (c) and 706.07(d). As set forth in MPEP 706.07, before final rejection is in order, a clear issue should be developed between the Examiner and the applicant. Applicant's Amendment filed January 9, 2006 amended claim 2 and cancelled claim 3, thereby overcoming one of the issues, namely the Examiner's claimed rejections under 35 U.S.C. §112. This first Amendment also substantially amended independent claim 1 as well as dependent claims 2, 4, 5 and 6 and added dependent claims 21, 22 and 23 to more particularly define the novel features of the invention.

As a result it is believed that the Examiner has now found that dependent claim 21 is allowable, as indicated by item no. 7 of the Office Action Summary, in which claim 21 is objected to but not expressly rejected. Although, the statements set forth in the "detailed action" on Action pages 2-9 make no further mention of claim 21, nevertheless, it is assumed that claim 21 is considered to be allowable if re-written to include all the limitations of the parent claim 1 on which it was previously dependent. The present Amendment accomplishes this by presenting new independent claim 24, which includes the limitations of cancelled claim 1 as previously amended, as well as the limitations of conditionally allowed claim 21, now cancelled.

In addition, applicants' previous Amendment filed January 9, 2006 presented arguments with a view to avoiding all of the grounds of rejections and objections of the Examiner set forth in the first Office Action. Moreover, there was no switching from one subject matter to another in the claims presented in the Amendment.

However, it is respectfully submitted that the Examiner in issuing a Final Rejection, in the second Office Action of March 24, 2006, has nevertheless relied upon new grounds of rejection. The Examiner now relies for the first time on the cited reference to Stavropoulos 4,426,213, as set forth in the rejection of claims 1, 6-8, 13-14, 22 and 24 (sic 23?) under 35 U.S.C. §103(a) under 35 U.S.C. §103(a) on Action pages 3, 4, 5 and 6. The Examiner in these Action sections presents a new, and it is respectfully submitted, erroneous interpretation of Stavropoulos '213 both as to its teaching and as to the drawing figures therein as cited and newly relied upon by the Examiner.

In the present Amendment applicants are seeking to respond to these newly presented issues, as well as to better define their invention in the remaining and amended claims in order to give to applicants the patent protection to which they are justly entitled. Applicants should not be prematurely cut off from the prosecution of this application by such a premature Final Rejection. Accordingly, it is believed that the finality of the Action should be withdrawn in order to enter and fully consider the present Amendment, and thereby provide applicants a fair and full hearing that should lead to allowance, or alternatively, to develop a clear issue(s) in the event of the necessity of an Appeal.

It is also respectfully submitted that the Examiner has seriously misinterpreted or misconstrued, alone or in combination, each of the references previously relied upon for the reasons set forth hereinafter as well as previously in the prior response. Therefore, it is

respectfully requested that the Examiner reconsider his rejection based on these references in favor of allowance, or alternatively, to at least base any further rejection upon a correct interpretation and combination of these references for the benefit of the applicants and the Board of Appeals.

**Amendment After Final Rejection Under 35 CFR 1.116(a) and (b)**

Alternatively to withdrawal of the finality of the Action dated March 24, 2006, entry of the instant Amendment pursuant to the provisions of 37 CFR 1.116 is respectfully requested. The present Amendment cancels fourteen claims, namely claims 1, 4, 6-10, 16-19 and 21-23, as, adds no claims to new subject matter, and incorporates the limitations of allowable dependent claim 21 into new independent claim 24 so as to incorporate all limitations of parent claim 1 as well as well as dependent claim 21 to render new claim 24 allowable.

The Amendment also presents independent claim 25, which is independent claim 1 as previously amended plus claim 21 that was conditionally allowed. However, claim 25 deletes the last limitations found in lines 9-15 of claim 21 directed to the configuration of the external surface of the restrictor. Such limitations are believed not necessary to the patentability of claim 2, but nevertheless set forth a preferred feature.

The Amendment also presents new independent claim 26 which is an independent claim directed to a hydraulic power steering system incorporating the limitations of claims 22, 23, 1, 6 and 4 in that order, and includes further amendments thereto better to distinguish patentably over the cited references.

Method claim 15 is the remaining independent claim and has been amended to incorporate in method terms those limitations of conditionally allowed claim 21 that are believed

to have been previously deemed by the Examiner to patentably distinguish over the cited references.

The remaining dependent claims are amended to change their dependency to be upon the foregoing independent claims and thus are allowable for at least the same reasons as the foregoing remaining independent claims.

Thus, as to any of the present amendments to the foregoing claims arguably touching the merits, the same are deemed necessary in order, inter alia, to distinguish patentably over the newly asserted Stavropoulos '213 reference. These amendments and arguments were not previously presented since this is the first opportunity to respond to these newly presented issues. Entry is also in order since this Amendment places the case in condition for allowance and, in any event, in better form for Appeal.

#### **Claim Rejections – 35 U.S.C. §102**

It is noted that the Examiner has withdrawn the previous rejection of claims 1, 5-8, 13 and 14 under 35 U.S.C. §102 (b) as being anticipated by Phillips 5,582,006. However, the Examiner has again rejected claims 15 and 1 for anticipation under 35 U.S.C. §102 (b) - again as based solely on the doctrine of inherency in turn based solely on the figures and the drawings in Phillips '006. Likewise, the Examiner also has again rejected claims 1, 6-8 and 13-15 under 35 U.S.C. §102 as being anticipated by the Katayama et al patent 4,285,534, again relying erroneously on the doctrine of inherency in turn based solely on drawing figures in Katayama.

These §102 rejections are again traversed for the same reasons set forth on pages 14-22 in the "Remarks" in the Amendment filed January 9, 2006, which are incorporated in toto herein by reference and again relied upon.

Nevertheless, claim 15 has been amended and claim 18 cancelled to thereby render these §102 issues moot for the time being, without prejudice to presentation of claims to the subject matter of original claims 15 and/or 18 in one or more continuing applications claiming priority of the present application.

It will be noted that method claim 15 has now been amended to add step (c), which brings in the novel features from conditionally allowed claim 21, thereby overcoming the prior rejections under both §102 and §103 and rendering claim 15 in condition for allowance. Method claim 20, which is dependent on claim 15, has been retained and is accordingly allowable for at least the same reasons as claim 15 as amended.

#### **Claim Rejections – 35 U.S.C. §103**

On page 3 of the Action, the Examiner cites “claims 1, 6-8, 13, 14, 22 and 24” (underscoring added) as being rejected under 35 U.S.C. §103(a). Since there was no claim 24 pending at the time of that rejection, it is assumed that the Examiner meant claim 23 rather than claim 24.

In the §103 rejection now of record, the Examiner has shifted grounds, and, although relying upon Phillips ‘006 and alternatively Katayama ‘534 for the same reasons as previously relied upon in the first Action, now combines Phillips ‘006 or Katayama ‘534 with the patent to Stavropoulos 4,426,213. Stavropoulos ‘213 was listed on page 5 of the previous Action as one of nine patents made of record but not relied upon, but rather being merely considered pertinent due to their disclosure of state of the art restrictors. However, now the Examiner shifts the basis of his rejection of claims 1, 6-8, 13-14, 22 and 23 to being unpatentable under §103(a) over Phillips, or alternatively being unpatentable over Katayama ‘534, both in view of

Stavropoulos '213. It is respectfully submitted that these new reference combinations compound the errors in the prior rejection and hence, the present rejection should be withdrawn.

Stavropoulos '213 is solely directed to and shows a flow constriction device for drainage of steam condensate in steam lines and the like. Hence, Stavropoulos has nothing to do with eliminating or reducing hiss-like noise and/or heat in a pulsation-absorbing flexible pipe, nor more generally to reducing turbulence in the outlet of a restrictor used in this type of pressure fluid device to thereby reduce hydraulic pressure line noise and/or heat.

As set forth in the Stavropoulos '213 patent, column 1, lines 9-30:

This invention relates to liquid drainage devices for fluid conduit systems. More particularly, this invention relates to devices for removing condensate from steam lines. (underscoring added)

Steam piping systems must be provided with equipment to remove the condensate which accumulates as heat is lost from the steam. Generally, condensate removal equipment is located at low points or pockets in the steam piping and at regular intervals in the extended runs of the steam piping, as well as at steam-driven equipment which could be damaged by condensate. Older equipment, such as the widely employed inverted bucket condensate trap, has increasingly been replaced with more simplified orifice devices, for example, those devices described in U.S. Pat. Nos. 3,715,870 and 3,877,895, in which a plate having an orifice is positioned in steam lines enabling condensate to be forced through the small diameter orifice by the high pressure steam; when the orifice is properly sized, condensate obstructs passage of steam through the orifice in order to minimize steam loss while permitting drainage of the condensate.

Provision of various size venturi tube inserts in the '203 patent is solely for this ability to facilitate provision of variation in diameter and length of the constriction which then can be made with a given size or standard size bore for service in a range of steam pressures. This has nothing to do with the use of a restrictor in a pulsation-absorbing flexible pipe for a hydraulic pressure fluid device, much less a hydraulic power steering system employing a

restrictor in a low pressure return line to pressure balance hydraulic fluid pressure forces in such a system. Such power steering return line restrictors create the source of the problem discovered solely by applicants, namely restrictor-induced turbulence causing generation of undue heat and/or a hiss-like noise in the system. Certainly there is no motivation, suggestion or teaching in Stavropoulos '213 that would have lead one of ordinary skill in the art to select and combine the references relied upon to make applicants' claimed invention as a whole. Therefore, the Examiner has failed to fulfill the requirement of the *Graham* Supreme Court to correctly analyze and articulate the basis on which the Examiner concludes that it would have been obvious to make applicants' invention as claimed. There is certainly no mention of reducing turbulence and/or hiss-like noise as a result of the use of the flow constriction device of the '213 patent. Nor does the Examiner explain how or why one would be motivated to substitute the structure of Stavropoulos '213 in Phillip '006 or Katayama '534 to achieve the novel results sought and achieved by applicants. Of course, Stavropoulos '213 is of no help in leading to applicants' discovery of the source of the hiss-like noise problem, much less the ancillary benefit of reducing heat formation from turbulence occurring in the restrictors of Phillips and Katayama.

For the benefit of the Examiner, copies are enclosed of the prior art patents cited in column 1 of the Stavropoulos '213 patent that more fully explain the art to which the '213 patent is directed, namely Guzick 3,715,870, Wonderland et al. 3,877,895 and Brown 4,171,209. These prior art references cited by Stavropoulos amply demonstrate that the Stavropoulos '213 patent is not analogous art and is of no use in supporting a §103 rejection as stated by the Examiner. It is requested that these three patents be made of record.

As secondary or tertiary references in support of Examiner's §103 rejection, the Examiner again refers to Moseley 3,894,562 and Van Ruiten 5,728,981. These patents again fail

to properly support a §103 obviousness rejection for the reasons set forth in the Remarks of the prior Amendment, again the same being incorporated herein by reference and again relied upon in support of applicants' claims for non-obviousness and patentability under §103. Nowhere in any of the patents cited of record to date is there to be found any motivation, suggestion or teaching that would have led the skilled artisan, at the time of applicants' invention, to substitute a particular type of venturi through-passage in the non-venturi restrictors of Phillips and/or Katayama to solve the turbulence-induced excess heat and/or hiss-like noise problems first noted solely by applicants and who first discovered the solution applicants have taught and claimed. Accordingly, under *In re Lee*, 277 F.2d 1338, 16 U.S.P.Q.2d 1430 (Fed. Cir. 2002), recently cited with approval by the Federal Circuit *In re Kahn* Fed. Cir. No. 04-1616, 3/22/06, the Examiner must explain the motivation, suggestion or teaching as part of his *prima facie* case. Otherwise, and lacking such explanation, the cited cases support the inference that the Examiner used hindsight to improperly conclude that the invention was obvious.

More particularly, a basic defect of the Examiner's initial and final rejection is the lack of any analysis of the cited prior art references relied upon that includes evidence relevant to the finding of whether there is a teaching, motivation or suggestion to select and combine the references relied on as evidence of obviousness. See *In re Sang Su Lee*, supra and cases cited therein. The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. There must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. Teachings of references can be combined only if there is some suggestion or incentive to do so. This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of



ordinary skill would have been lead to this combination of references simply to use that which the inventor taught, against its teacher. Since it is clear that the prior art contains no motivation or suggestion to modify or combine the cited references to provide the apparatus and method now set forth in the claims as presently amended and remaining, a *prima facie* obviousness showing has not been made.

While it is agreed that one cannot show non-obviousness by merely attacking references individually where the rejections are based on combinations of references, by the same token, the *In re Sang Lee* decision, supra, and many Federal Court decisions cited therein make it clear that one cannot show non-obviousness by combining references without complying with a rigorous application of the requirement for the showing of motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant, and the factual inquiry in this regard must be thorough and searching and stated of record. Thus again, on the record to date a *prima facie* showing of non-obviousness has not been established.

#### **Additional Prior Art Made of Record by the Examiner**

The Examiner in his “**Conclusion**” on page 7 of the second Action cites further prior art patents to Gargin 1,847,085 (using a venturi tube 35 to create a pressure difference that is part of an electrical controlling circuit for controlling the rate of flow of a liquid), Walch 2,146,100 (various forms of venturi used in steam pumps of the jet type, such as inspirators or injectors), Sweet, Jr. 2,223,242 (venturi construction used in a steam jet exhauster and constructed to withstand the effect of acid corrosive vapors) and Chenault 3,146,798 (venturi type flow controller useful as a governor applied to a hydraulically operated sub-surface motor and pump combination used in an oil well). Thus, it is respectfully submitted that such additional references are either not pertinent, or at best, merely cumulative to the §103 -

inadequate disclosures of the cited Phillips '006, Katayama et al. '534, Moseley et al. '562, Van Ruiten '981 patents and the newly cited and relied upon Stavropoulos '213 patent.

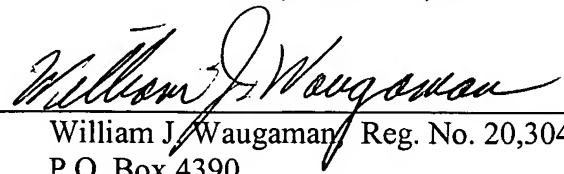
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In short, none of the claims 1-20 as filed, and clearly none of the claims 1, 2 and 4-23 as previously amended and presented, and certainly none of the claims remaining at issue, namely claims 2, 5, 11, 12, 13, 14, 15, 20, 24, 25 and 26, are in any way "anticipated" by any one of the reference patents cited to support an alleged 35 U.S.C. §102(b) rejection, nor are any of these claims rendered obvious under 35 U.S.C. §103 over any proper combination of any one or more of these patent references of record. Accordingly, in view of the foregoing amendments and Remarks, this application now appears to be in condition for allowance with claims 2, 5, 1-15, 20 and 24-26 as amended and/or newly presented, and such action is respectfully solicited.

Enclosed please find Check No. 9097 in the amount of \$400.00 in payment for the two additional independent claims presented with this Amendment. If it is determined that any additional fees are due with this submission, the Commissioner is hereby authorized and respectfully requested to charge such fee to our deposit account no. 50-0852.

Respectfully submitted,

REISING, ETHINGTON, BARNES, KISSELLE, P.C.

By   
William J. Waugaman Reg. No. 20,304  
P.O. Box 4390  
Troy, Michigan 48099  
Telephone (248) 689-3500  
Facsimile (248) 689-4071

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Enclosures